

alkoxylation) product, the alcohol product (or alkoxylation) and a nonionic surfactant composition comprising the alkoxylation product;

Group II: Claim 23, drawn to a method for preparing a surfactant;

Group III: Claim 24, drawn to a method for preparing glycoside and polyglycoside mixtures;

Group IV: Claim 25, drawn to a method for preparing a surface-active sulfate; and

Group V: Claim 26, drawn to a method for preparing surface-active phosphates.

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct. The burden of proof is on the Office to provide reasons and/or examples to support any conclusion with regard to patentable distinctness. MPEP §803.

Applicants respectfully traverse the requirement for restriction on the grounds that the Office has not provided adequate reasons and/or examples to support a conclusion of patentable distinctness between the identified groups.

The Examiner, citing PCT Rule 13.1 and 13.2, contends that Groups I-V do not relate to a single general inventive concept because they lack the same or corresponding special technical features. However, Applicants traverse the Restriction Requirement on the grounds that the Office has not applied the same standard of unity of invention as the International Preliminary Examination Authority. The Authority did not take the position that unity of invention was lacking in the International application and examined all claims together (see the International Preliminary Examination Report appended herewith). Applicants note that PCT Article 27(1) states that no national law shall require compliance with requirements relating to the form and contents of the International application different from or additional to those which are provided for in the Patent Cooperation Treaty and the Regulations.

In fact, Applicants point to Section V of the International Preliminary Examination Report, in which the International Authority found the present invention to possess novelty, as well as inventive step.

Moreover, the MPEP in §803 states as follows:

"If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

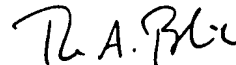
Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office. In fact, the International Searching Authority has searched all of the claims together.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the requirement for restriction. Withdrawal of the requirement for restriction is respectfully requested.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER, & NEUSTADT, P.C.



Norman F. Oblon
Attorney of Record
Registration No.: 24,618

Thomas A. Blinka
Registration No: 44,541



22850

Tel.: (703) 413-3000

Fax: (703) 413-2220

NFO:TAB

I:\ATTY\TAB\2003\MAY 2003\213301.RESTRICTION DRAFT.DOC

Translation

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

10

| | | |
|---|---|--|
| Applicant's or agent's file reference NAE19980876PC | FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416) | |
| International application No. PCT/EP00/02416 | International filing date (day/month/year) 17 March 2000 (17.03.00) | Priority date (day/month/year) 19 March 1999 (19.03.99) |
| International Patent Classification (IPC) or national classification and IPC C07C 2/10 | | |
| Applicant BASF AKTIENGESELLSCHAFT | | |

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.

2. This REPORT consists of a total of 5 sheets, including this cover sheet.

This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of _____ sheets.

3. This report contains indications relating to the following items:

- I Basis of the report
- II Priority
- III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- IV Lack of unity of invention
- V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI Certain documents cited
- VII Certain defects in the international application
- VIII Certain observations on the international application

| | |
|--|--|
| Date of submission of the demand 17 October 2000 (17.10.00) | Date of completion of this report 14 February 2001 (14.02.2001) |
| Name and mailing address of the IPEA/EP | Authorized officer |
| Facsimile No. | Telephone No. |

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/EP00/02416

I. Basis of the report

1. This report has been drawn on the basis of (Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to the report since they do not contain amendments.):

- the international application as originally filed.
- the description, pages 1-21, as originally filed,
 pages _____, filed with the demand,
 pages _____, filed with the letter of _____,
 pages _____, filed with the letter of _____.
- the claims, Nos. 1-18, as originally filed,
 Nos. _____, as amended under Article 19,
 Nos. _____, filed with the demand,
 Nos. _____, filed with the letter of _____,
 Nos. _____, filed with the letter of _____.
- the drawings, sheets/fig _____, as originally filed,
 sheets/fig _____, filed with the demand,
 sheets/fig _____, filed with the letter of _____,
 sheets/fig _____, filed with the letter of _____.

2. The amendments have resulted in the cancellation of:

- the description, pages _____
- the claims, Nos. _____
- the drawings, sheets/fig _____

3. This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

4. Additional observations, if necessary:

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/EP 00/02416

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

| | | | |
|-------------------------------|--------|------|-----|
| Novelty (N) | Claims | 1-18 | YES |
| | Claims | | NO |
| Inventive step (IS) | Claims | 1-18 | YES |
| | Claims | | NO |
| Industrial applicability (IA) | Claims | 1-18 | YES |
| | Claims | | NO |

2. Citations and explanations

1. Document DE-A-43 39 713 (D1) is considered the closest prior art and discloses a catalytic method for oligomerising unbranched C₂-C₆-olefins for producing softeners.
2. The present application addresses the problem of devising a new method for economically producing surfactant alcohols with low ecotoxicity and high biodegradability.
3. The solution is the method as per Claim 1 [steps (a) to (c)], characterised in that an olefin is used as starting material containing in total at least 60 % by weight hexene isomers, of which 30-80% by weight linear hexene isomers. D1 does not describe this starting material. Claim 1 therefore meets the requirements of PCT Article 33(2).
4. Example 3 of D1 uses as starting material a **linear olefin** comprising a butane/butene mixture, of which 33% by weight n-butane, i-butane and the remaining 67% by weight comprising 11% by weight 1-butene, 35% by weight trans-2-butene, 20% by weight cis-2-butene, and only 1% by weight butene. That document

points away from the use of branched olefins as starting material. Although a person skilled in the art could have used a mixture of branched and linear olefins, there are no indications that good surfactant alcohols or their esters could be obtained in this way. Claim 1 therefore also meets the requirements of PCT Article 33(3).

5. Independent Claims 5 and 12 concern olefin mixtures (according to step (a)) and surfactant alcohols and alkoxylation products, respectively [(intermediate) products produced by steps (a) and (b) or (a), (b) and (c)]. These products constitute an alternative to known products and show advantageous properties, that is low ecotoxicity and good biodegradability. These claims therefore also meet the requirements of PCT Article 33(2) and (3).
6. Claims 2-4 and 13 are dependent on Claims 1 and 12, respectively. Claims 14-18 concern the use of the surfactant alcohols as per Claims 12-13. These claims therefore also meet the requirements of PCT Article 33(2) and (3).

VII. Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

7. Contrary to PCT Rule 5.1(a)(ii), the description does not cite document D1 and does not indicate the relevant prior art disclosed therein.